



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/497,552	02/03/2000	Guido Maurizio Oliva	3572-15	7648

7590 07/31/2002

Nixon & Vanderhye P C  
1100 N Glebe Road 8th Floor  
Arlington, VA 22201

EXAMINER

LESTER, EVELYN A

ART UNIT	PAPER NUMBER
----------	--------------

2873

DATE MAILED: 07/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/497,552

Applicant(s)

OLIVA, GUIDO MAURIZIO

Examiner

Evelyn A. Lester

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27 and 28 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 11-15, 29 and 32-36 is/are rejected.
- 7) ☒ Claim(s) 6-10 and 16-26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Page No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

PRIMARY EXAMINER

Part of Paper No. 11

GROUP 2870

Art Unit: 2873

## DETAILED ACTION

### *Election/Restriction-With or Without Traverse*

1. Applicant's election of Group I in Paper No. 8 was acknowledged in paper No. 9. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Therefore, no correction to the Examiner's statement that the election was made without traverse is required.

### *Election/Restriction-Claim Rejoinder*

2. Claim 1 is directed to an "allowable" product, with the exception of the obviousness-type double patenting rejection (note following paragraphs of this office action). Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), claims 6-10, 16-28, 30 and 31, previously withdrawn from consideration as a result of a restriction requirement, are now subject to being rejoined. Claims 6-10, 16-28, 30 and 31 are hereby rejoined and fully examined for patentability under 37 CFR 1.104.

Since all claims previously withdrawn from consideration under 37 CFR 1.142 have been rejoined, the restriction requirement made in Paper No. 7 is hereby withdrawn.

Art Unit: 2873

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 32-35 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Plesko (U.S. patent 5,886,332).

Please note Figures 9, 10A and 10B and their accompanying text. Especially note text at column 7, lines 3-42.

Plesko discloses the claimed invention of an optical device for focusing a laser beam which comprises a focusing lens(2, 320) upon which the laser beam (from source S) is directed and a first mean for selection only a central portion of the laser beam wherein the first means is directly applied on the focusing lens. Further wherein the laser beam is substantially elliptical and astigmatic beam.

With respect to claim 34, Plesko's invention is adapted to obstruct the propagation of periphery portion by scattering.

***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine

Art Unit: 2873

grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 2, 4, 5, 11-15, 29 and 32-36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of copending Application No. 09/773,384 (which is also published application number US 2002/0050517 A1, filed on February 1, 2001). Although the conflicting claims are not identical, they are not patentably distinct from each other because the applications each claimed invention is only a merely variation of the other.

Each claimed invention recites an optical device, wherein a laser light beam is focused by a

Art Unit: 2873

focusing lens and is itself the diaphragm (claim 1 of the instant invention and claim 13 of the other application's claimed invention), and wherein the central portion of the laser light beam propagates or is emitted, and further wherein the aperture has a Fresnel number less than 2.

Clearly the boundary or scope of the claimed inventions are the same, with only obvious variations which would have been known to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### *Allowable Subject Matter*

5. Claims 6-10, 16-26, 30 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 27 and 28 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter:

The reasons for indicating allowable subject matter were given in paper no. 9.

#### *Response to Arguments*

8. Applicant's arguments with respect to claims 1,2 and 4-36 have been considered but are

Art Unit: 2873

moot in view of the new ground(s) of rejection.

Further, the Applicant is respectfully reminded of the duty of disclosure as outlined, for example, in the MPEP 2001.06(b) and 2004, paragraphs 9 and 10.

*Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to E.A. Lester whose telephone number is (703) 308-4943. The examiner can normally be reached on Monday-Friday from about 9:30 am to 6 pm (subject to an extended flex schedule).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps, can be reached on (703) 308-4883. The fax number for Technology Center 2800 is (703) 308-7724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Evelyn A. Lester  
Primary Examiner  
AU 2873  
July 28, 2002